Supreme Court of the United States.

October Term, 1898.

Filed Feb. 27, 1899.

EMILIE SAXLEHNER,

Petitioner,

vs.

EISNER & MENDELSON CO.

SAME

vs.

SIEGEL-COOPER CO.

SAME

vs.

RUDOLPH GIES.

SAME

vs.

LOUIS MARQUET.

BRIEF FOR RESPONDENT OPPOSING APPLICATION FOR WRIT OF CERTIORARI.

EDMUND WETMORE,

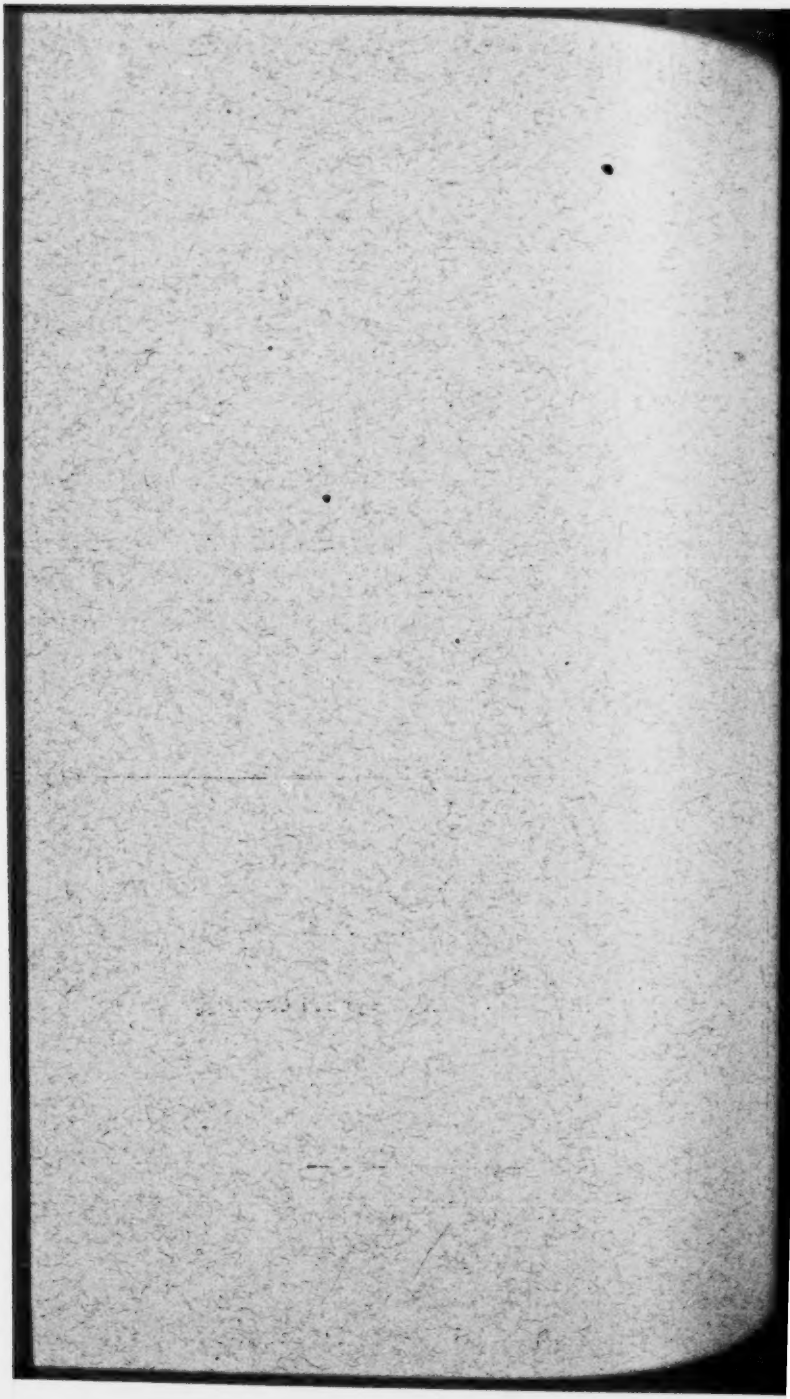
CHARLES G. COE,

Attorneys and Counsel for Respondent.

NEW YORK:

John Polhemus Printing Company, Printers and Mf'g. Stationers, 121 Fulton Street.

1899.



Supreme Court of the United States

OCTOBER TERM, 1898.

EMILIE SAXLEHNER, Petitioner, *In re* petition for a Writ of *Certiorari* requiring the Circuit Court of Appeals in and for the Second Circuit to certify to the Supreme Court for review and determination the case of

EMILIE SAXLEHNER,
Complainant-Appellant,

vs.

EISNER & MENDELSON COMPANY,
Defendant-Appellant.

SAME

vs.

SIEGEL-COOPER COMPANY.

SAME

vs.

RUDOLPH GIES.

SAME

vs.

LOUIS MARQUET.

Brief Opposing Petition for Writ of Certiorari.

The main reasons why the petitioner asks for the writ of *certiorari* on the ground of error by the Circuit Court of Appeals is contained in the Ninth, Tenth, Eleventh and Twelfth sections of the petition herein, and is substantially to the effect that said Court erred by deciding that laches of nine years' duration was sufficient to bar the right to an injunction; that said Court so decided on the supposed authority of *Menendez* vs. *Holt;* and that the action of said Court of Appeals in so holding, is opposed to the law as laid down in the previous case of *McLean* vs. *Fleming*; that said action of the Court of Appeals is also subversive of the rights guaranteed to the petitioner by the treaty between the United States of America and Austro-Hungary; and finally that the Court of Appeals committed grievous error in overlooking the action of the Hungarian authorities with regard to the word "Hunyadi" in 1896, which Hungarian litigation is substantially urged in the brief of petitioner as constituting a valid excuse for her non-action in the United States during the period intervening between 1888 and the Spring of 1897, when the suit herein was commenced.

With reference to these assignments of alleged error we contend that the Circuit Court of Appeals decision shows on its face, that the Court did not decide that mere lapse of time for nine years barred the right to injunctive relief, but that it was not only the delay for nine years, but such delay continued for nine years *under circumstances showing surrender and loss of rights by acquiescence which led the Court to its decision.*

A review of the Supreme Court authorities will also show that the decision of the Court of Appeals is not opposed to the law laid down in *McLean* vs. *Fleming*, *Menendez* vs. *Holt*, and subsequent decisions of this Court where all relief has been denied

on account of loss of rights by surrender and acquiescence.

It is true that the Supreme Court of the United States in the year 1887, in the suit of *McLean* vs. *Fleming*, 96 U. S. Rep., 245, laid down the general proposition that mere delay in bringing suit on a trade mark, while it will defeat the right to recover for past profits, will not ordinarily prevent injunctive relief.

In the year 1888, in the suit of *Menendez* vs. *Holt*, 128 U. S. Reports, 514, the Supreme Court was asked to reconsider the general proposition laid down in *McLean* vs. *Fleming*, but refused to do so. The Court, however, was very careful to state that this was a mere general proposition, and that the facts disclosed by the record in this suit of *Menendez* vs. *Holt* did not justify the Court in treating the case as an exception to the general rule.

The opinion of the Court makes it evident that in a case where proof of non-user of the trade mark by the owner, or surrender of the use to the public by acquiescence, or otherwise, is shown, it would unhesitatingly refuse injunctive relief.

A most excellent summary of the authorities bearing on this point is found in the suit of *Prince's Metallic Paint Co.* vs. *Prince Manufacturing Co.*, reported in 57 Fed. Rep., p. 938, in which case the Court denied complainant all relief on account of eight years' acquiescence. The Court says at page 944 of said report as follows:

"*Now, it is true that, where the plaintiff's title to a trademark is clear, mere delay, unaccompanied by anything else, will not ordinarily bar a suit for injunction against a naked infringer. Fullwood* vs. *Fullwood, 9 Ch. Div., 176; McLean* vs. *Fleming, 96 U. S., 245; Menendez v. Holt, 128 U. S., 514, 9 Sup. Ct. Rep., 143. But we are dealing with no such case. In courts of equity the rule is to withhold relief where there has been unreasonable delay in prosecuting a claim, or long acquiescence in the assertion of adverse rights. Creath's Adm'r* vs.

Sims, 5 How., 192; Godden vs. *Kimmell, 99 U. S., 201; Lansdale* vs. *Smith, 106 U. S., 391, 1 Sup. Ct. Rep., 350. Again and again has it been judicially declared that nothing can call into activity a court of equity but "conscience, good faith and reasonable diligence." McKnight* vs. *Taylor, 1 How., 161; Sullivan* vs. *Railroad Co., 94 U. S., 806, 812. In McLaughlin* vs. *Railway Co., 21 Fed. Rep., 574, Judge Brewer held a bill for the infringement of a patent, alleging the unauthorized use and construction of a patented invention for 13 years, without stating an excuse for the plaintiff's delay in suing, to be demurrable. Laches for even less than the statutory period of limitations, aided by other circumstances, will bar a right. Ashhurst's Appeal, 60 Pa. St., 290, per Strong, J. In Lewis* vs. *Chapman, 3 Beav., 133, the Master of the Rolls refused an injunction to restrain the infringement of a copyright solely on the ground of six and a half years' delay, where there was knowledge of the commencement and prosecution of the defendant's publication. Long acquiescence before filing a bill for an injunction, with full knowledge of the infringement, is deemed laches equivalent to a breach of good faith. Browne, Trade-Marks, Sec. 497. Hence, in Manufacturing Co.* vs. *Garner, 55 Barb., 151, a delay of nine years in applying for an injunction to restrain infringement of a trademark was held to be good cause for refusing it"*

In the said suit of *Godden against Kimmell*, 99 U. S. Reports (1878), from pages 210 to 212, a summary of Supreme Court authorities is found in regard to the effect of laches and negligence in the assertion of alleged rights.

In *Galliher against Cadwell*, 145 U. S., 368 (1891), where plaintiff's claim was defeated on the ground of the inequity of enforcing it, the Court, at pages 372 and 373 of said report, 145 U. S., says as follows:

"*The cases are many in which this defense has been invoked and considered. It is true that by reason of their differences of fact no one case be-*

comes an exact precedent for another, yet a uniform principle prevades them all. They proceed upon the assumption that the party to whom the laches is imputed has knowledge of his rights and an ample opportunity to establish them in the proper forum; that by reason of his delay the adverse party has good reason to believe that the alleged rights are worthless or have been abandoned, and that because of the change of condition or relations during this period of delay, it would be an injustice to the latter to permit him to assert them."

Then follows a citation of Supreme Court cases in which laches of this description ranging from two to seven years was held fatal to the enforcement of the claim. At page 373 the Court then says as follows:

"*But it is unnecessary to mulliply cases. Nearly all proceed upon the theory that laches is not like limitation, a mere matter of time; but principally a question of permitting the inequity of the claim to be enforced and an inequity founded upon some change in the condition or relations of the property or parties.*"

In the subsequent suit of *Coats* vs. *Merrick Thread Co.*, 149 U. S. Rep., p. 562, the Court held that acquiescence of twelve years was sufficient to debar complainant from relief. The Court says as follows, at page 573 of said report:

"*Indeed, the intent to imitate plaintiffs' spool*
"*heads, if any such intent existed, is manifest*
"*rather in the label than in the periphery, but*
"*plaintiffs having submitted to this without pro-*
"*test for twelve years, have waived their right to*
"*relief upon this ground. McLaughlin* v. *Peoples*
"*R. Co., 21 Fed. Rep., 574; Ladd* v. *Cameron, 25*
"*Fed. Rep., 37; Green* v. *French, 4 Bann. & Ard.,*
"*169, 3 Robinson, Patents, Sec. 11-94.*"

The above review of authorities shows clearly that there are cases in which this Court has refused injunctive relief on the ground that the complainant

has lost all right to such relief by surrender and acquiescence.

Whether or not such right has been lost in any particular case is only a question of fact, and such is the present case. It presents no question of law, but purely one of fact, and the facts, as appears by the record, are voluminous. They are, as held by the Court of Appeals, fully rehearsed in the opinion of the Circuit Court. Of these facts, the most striking and conclusive are here set forth:

THE APOLLINARIS CONTRACT.

The first fact which is dwelt upon by the Court of Appeals as one of the circumstances accompanying the long continued delay which led the Court to its decision, is the contract made between the Apollinaris Company, Limited, with the predecessor of the complainant, and the agreements and actions of both parties connected therewith.

On February 8th, 1876, a contract was entered into between Andreas Saxlehner, the predecessor of complainant, and the Apollinaris Company, Limited, by which contract said company was granted the sole and exclusive right to sell the waters of the Hunyadi Janos Springs in all parts of the world except the continent of Europe and Smyrna.

In the exact language of the contract, Saxlehner "abandons" to the Apollinaris Company the exclusive sale of his Hunyadi Janos water within the prescribed territory.

By this contract it was further provided that Saxlehner was bound to refuse all orders for the Hunyadi Janos bitter water which he knew, or had good reason to suppose, were intended for places reserved for the Company by the said contract, and make over the same to the Company.

On its part the Company agreed not to introduce any other bitter water during the period of the contract. It was further agreed in said contract that the

Company should buy a specified number of bottles yearly, which Saxlehner agreed to sell at a specified price.

This contract was originally made for the term of ten years, beginning the first of January, 1876.

The parties proceeded under this original agreement for about a year, evidently to their mutual satisfaction, since on or about February 15th, 1877, the term of said contract was extended to fifteen years from January 1st, 1886—that is to say, substantially for the period of twenty-five years from February 8, 1876.

The contract further provided that the Apollinaris Company might terminate the same at any time during this period by giving twelve months previous notice. Saxlehner had no such right, so that the sole power to terminate the contract, prior to the expiration of its term, was given exclusively to the Apollinaris Company.

Such notice was given in the month of March, 1895, by the Apollinaris Company, and in pursuance of said notice the contract terminated on March 25, 1896.

Almost simultaneously with the making of this agreement, Saxlehner and the Apollinaris Company agreed to print the labels on the bottles which were sold to the Company in red and blue colors instead of in red and white, as Saxlehner used them on the continent of Europe.

In order to give all persons interested and the public generally, notice of the rights of the Apollinaris Company, the following notices were placed upon the labels: "Sole Exporters: The Apollinaris "Company, Limited, London." And also the following:

"Imitation of this water, or of the label, or of the "capsule, will be the subject to legal proceedings at "the instance of the Apollinaris Company, Limited, "19 Regent street, London.

"ANDREAS SAXLEHNER."

The evidence shows that on each and every bottle furnished by Saxlehner to the Apollinaris Company, labels were affixed at Budapest, having the words above quoted thereon.

For the purpose of still protecting the sale and right of the Apollinaris Company to the label and name, such label with the said words thereon was registered, and a trade-mark obtained for the name, "Hunyadi Janos" by Saxlehner in the United States on September 11, 1877.

It is further shown by the evidence that prior to the Apollinaris contract of 1876, the sales of Hunyadi Janos water in the United States were trivial, and such water was substantially unknown here. The water was introduced and made known to the people of the United States by the Apollinaris Company, all the expenses of such introduction and marketing being borne by the Company.

It is further shown that the said Hunyadi Janos water was extensively and exclusively advertised by the Apollinaris Company during the period of the contract at its own cost and without expense to Saxlehner.

Under these circumstances, it may well be held that it was the intention and design of both parties to the contract, that such contract and the agreements connected therewith, delegated to the Apollinaris Company all the powers, and vested such Company with all the rights in the prescribed territory for the period of the contract, which Saxlehner would have had if such contract had not been made, and which powers and rights he reserved to himself in his own territory.

If such be the interpretation of the contract, then the Apollinaris Company stood for Saxlehner, and was a principal in said territory for the period of the contract, and its action and failure to act were the action and non-action of Saxlehner. If, on the other hand, it be held, as the complainant strenuously contended, that the relations of the Apollinaris Company and Saxlehner during the period

of the contract were those of vendee and vendor, then, as the Court of Appeals says, Saxlehner was bound to know the situation in the United States with regard to the sale of Hunyadi water, and is chargeable alike with the actions and conduct and failure to act of the Apollinaris Company. In the one case, the Apollinaris Company was the principal for the period of the contract, and thus its action or non-action was Saxlehner's action or non-action, and in the other, Saxlehner was chargeable with the knowledge of what her vendee was doing or not doing in the United States.

It is obvious, that whatever the precise legal relations of the parties to the contract were, the Apollinaris Company was held out to dealers in mineral waters, all persons interested in the sale of Hungarian bitter waters, and the public generally, as the sole representative of Saxlehner in the United States, as the suppressor of infringements, and the only person with whom any one could deal during the period of the contract.

LOSS AND SURRENDER OF SAXLEHNER'S RIGHTS BY ACQUIESCENCE AND COMPLAINANT'S KNOWLEDGE OF SAME.

The remaining circumstances on which the Court of Appeals based its decision that all right to the name Hunyadi, and to the label, had been lost and surrendered by acquiescence, were the abandonment of the injunctions in the Hunyadi Matyas and Hunyadi Arpad suits in 1888; the adoption and use by the Apollinaris Company of the diamond mark, the free sale of the Hunyadi Arpad, Hunyadi Laszlo, and Hunyadi Bela waters after 1888, and the Hunyadi Matyas and other waters since 1890; the publication on April 6th, 1889, by the Apollinaris Company of the announcement with regard to the use of the diamond mark, which publication was continued in trade papers thereafter in 1889 and 1890, and the publication and widespread circulation by postal

cards to physicians, by circulars to the trade, and by advertisements in the trade papers and newspapers generally throughout the United States by the Apollinaris Company, of the announcement of 1893, that the word "Hunyadi" had become a generic or general name for Hungarian bitter waters; the entire absence of any protest to the public of the United States by Saxlehner against such acts, and her utter failure to either act herself or compel the Apollinaris Company to act for the period of nine years.

To the above facts and circumstances is to be added, that the evidence on the part of defendant shows, that during said nine years, the word Hunyadi and the red and blue label had become among dealers in mineral waters, the trade and the public generally, the general and generic name for Hungarian bitter waters, which had been imported and sold here under said name and label to the amount of hundreds of thousands of bottles a year.

These were some of the facts and circumstances, which accompanied by the long lapse of time, led the Court of Appeals to its decision. The said Court finds that the complainant is chargeable with the knowledge of these facts and circumstances, but it is shown by the evidence that not only is she chargeable with such knowledge, but that there are also circumstances, which prove clearly that she must have had actual knowledge so far as regards the sale of Hunyadi Matyas, Hunyadi Arpad, and Hunyadi Laszlo waters in the United States.

It is proved by undisputed facts that from 1890 to 1896, when the Apollinaris contract terminated, that the labels exhibiting the words "Hunyadi Matyas" conspicuously on their front, were affixed to the Hunyadi Matyas bottles at Budapest, where the Hunyadi Matyas springs were situated, and shipped thence to be sold here by the Eisner & Mendelson Co. under its 1890 lease.

The Hunyadi Arpad springs were also situated in Budapest, and from 1888, when the Hunyadi Arpad

injunction was abandoned, until 1893, when the Hunyadi Arpad springs were bought up by Saxlehner as hereinafter more particularly detailed, such Hunyadi Arpad water was shipped to the United States in bottles with the red and blue label affixed thereon such as had been used previous to the 1888 injunction, to be sold by the agents of the spring in this country.

The evidence shows that during those respective periods the yearly output of these "Hunyadi" waters, using said red and blue labels, which were sold without let or hindrance in the United States, amounted to hundreds of thousands of bottles.

It is impossible, therefore, to believe in the face of these facts, that the complainant and her predecessor having the Hunyadi Janos springs and their business establishment in the City of Budapest, did not know that such waters were being shipped under the red and blue label to the United States for sale here.

Indeed, so far as regards the sale of Hunyadi Matyas water, the member of the Saxlehner firm who testified in this suit, would not deny that said firm had such knowledge, for when asked whether the firm knew of the sale of Hunyadi Matyas water in the United States, said, "I don't know; *Maybe they knew.*"

This same witness testified that as early as 1891, complainant's firm knew that the Apollinaris Company was affixing to the bottles of Hunyadi Janos water sold by said Company, the diamond mark or brand, and that said Company continued to use the same during the remaining period of the Apollinaris contract.

The complainant, therefore, being familiar with the fact that the Apollinaris Company used the diamond mark on the red and blue Hunyadi Janos label, must also necessarily have acquired the knowledge and been familiar with the circumstances in the United States which made the use of this mark by the Apollinaris Company necessary, in

order to distinguish the Hunyadi Janos water from the other Hunyadi waters using the red and blue label.

But the most important fact which brings directly home to the complainant, her knowledge of of the sale of Hunyadi Arpad, Hunyadi Matyas and Hunyadi Laszlo waters in the United States, is her buying up the Hunyadi Arpad and Hunyadi Bela springs in the summer of 1893.

At this time the Eisner & Mendelson Co. were selling the Hunyadi Arpad and Hunyadi Bela waters under their red and blue labels, under an arrangement with Ungar, the owner of said springs, by which said company had been made the sole and exclusive seller of the same in the United States. They were also selling the Hunyadi Laszlo water by a like arrangement with its owner, and were selling the Hunyadi Matyas water under the 1890 lease, and had advertised such waters and themselves as exclusive sellers thereof in trade papers and in other ways.

On July 6th, 1893, the Hunyadi Arpad and Hunyadi Bela springs were bought by the complainant of Ungar, their owner, the springs closed, and the importation of these waters to the United States, to be here sold by the Eisner & Mendelson Company, stopped.

It was further shown that the price paid by complainant was two-hundred and twenty-five thousand florins (Fl. 225,000), or seventy-five thousand dollars ($75,000), ten thousand dollars of which, or its equal in value, being received by the Eisner & Mendelson Company for its contract.

The above circumstances taken together show either actual knowledge, or such a state of facts as must necessarily and inevitably have led the complainant to a knowledge of the situation with regard to the sale of Hunyadi waters during the period of the Apollinaris contract, from 1888 on, on which situation, the defendant relied for its defense, and on which the Circuit Court of Appeals founded its opinion.

THE AUSTRO-HUNGARY TREATY MATTER.

The petitioner's counsel claim substantially that the treaty provides that the reproduction of a trade mark forbidden in Austro-Hungary is forbidden in the United States; that the use of the word "Hunyadi" as a trade-mark by others than the complainant was not forbidden until 1896, and that until that time, the fact that it was not so forbidden in Austro-Hungary constituted a serious obstacle to suits against its use in this country, but that the moment that its use was forbidden in Hungary in 1896, the provision of the treaty applied, and its use became unlawful here, and that in a suit brought on such trade-mark in the United States thereafter, the defendant could not set up the defense of loss and surrender of rights by acquiescence during the intervening nine years.

This contention is completely disposed of by the Court of Appeals in its denial of the motion for a re-argument.

In addition to the reasons there given, there are other considerations which deprive the petitioner's contention of all force. There never was a moment when the existence of the treaty interposed the slightest obstacle to a suit in this country to enforce the trade-mark derived from *use* in the United States. The precise bill filed in this suit might have been filed against any person using the name or label ever since their introduction into this country through the Apollinaris Company in 1876. The registration of the word "Hunyadi" as a United States trade-mark in the year 1887, is stated in the bill of complaint, but the suit is not brought upon the registered trade-mark, nor to enforce a statutory remedy. It is brought to enforce an alleged common law right, pure and simple, and to prevent unfair competition. The treaty therefore, has no application.

Moreover, it is not possible to construe such treaty to mean that our Courts could abridge the rights of American citizens to set up the defense of

loss of rights by acquieseence on part of complainant because of any decisions given or laws passed in a foreign country. The treaty only gives to a citizen of Austro-Hungary the right to sue to restrain the infringement of a trade-mark here, "just as if the plaintiff were a citizen of this country." It does not give the Austro-Hungarian a right which a citizen of this country does *not* possess, or relieve him from the effect of acquiescence, which, under our laws would be fatal to his claim.

It is further to be noted that the suggestion that the rights of the party to this suit were affected by the treaty was never made in any manner or form, nor did it appear in any of the pleadings, evidence or briefs, *nor was it referred to in any argument throughout the entire litigation*, until brought forward by petitioner on motion for a re-argument in the Court of Appeals. This shows clearly that this treaty matter was a mere after thought to which the petitioner had theretofore attached no importance whatever.

But there is another fatal objection to the enforcement of any alleged rights under the treaty. The treaty provides that if "*the trade-mark has be-*" *come public property in the country of its origin,* "*it shall be equally free to all in the countries or* "*territories of the other of the two contracting* "*parties.*"

For some fourteen years prior to the year 1887, the evidence shows that the word "Hunyadi" had been used in Hungary, under the sanction of its laws, as a general name to designate springs of Hungarian bitter water belonging to other persons than the owner of the Hunyadi Janos Springs.

The beginning of such use of the word Hunyadi is well stated in a condensed form, by the Circuit Court in Judge Shipman's opinion as follows:

"*In 1873, one Ignatius Markus, the proprietor* "*of a spring of bitter water in Budapest, applied* "*to the City authorities for permission to call the*

"spring and its water by the name "Hunyadi "Matyas," and to register this name as a designa- "tion of the water. This application was success- "fully opposed by Saxlehner before the local "authorities, but the decision was reversed upon "appeal to the Minister of Agriculture, who held "that the two names were sufficiently distinct and "that it sufficiently appeared that the waters of "the springs were of the same quality, and granted "Markus' petition. Afterwards this spring was "registered in Budapest by the name of Hunyadi "Matyas."

After this decision, and prior to 1887, the Hunyadi Arpad, Hunyadi Laszlo, Hunyadi Erzebet and Hunyadi Bela, as well as the Hunyady Matyas waters were sold freely in Hungary under these designations.

From the above, it is clear that the word "Hunyadi," was not the sole and exclusive property of the Saxlehner firm, but had become the common designation of a number of other springs by the direct authority and sanction of the Hungarian trade mark authorities.

The evidence further shows that in 1888, the motion to vacate the injunction in the Hunyadi Arpad suit was made by the defendant Ungar on this very ground, namely, that the word "Hunyadi" had, prior to that time, become a general and generic name in Hungary, and that it was in view of the history of said word in Hungary as embodied in the affidavits filed to vacate, that the Apollinaris Company failed to contest, and discontinued the Hunyadi Arpad and Hunyadi Matyas 1888 injunctions, and abandoned the suits.

We contend, therefore, that if the treaty is to be considered at all, the above facts are fatal to its application in this suit.

THE AUSTRO-HUNGARIAN DECREES.

It is also claimed by the petitioner that the Courts below have overlooked or disregarded the asserted facts, that the Minister of Commerce in Hungary struck from the registry of trade marks, in the year 1894, all pictorial trade marks bearing the words Hunyady Matyas, Hunyadi Laszlo, etc., and that in 1896, struck from the registry, the word trade-marks, Hunyady Matyas, Hunyadi Laszlo, Hunyadi Lagos, and a number of other designations using the word Hunyadi, which trade marks had all been registered under the law of 1895 allowing their use.

The decrees of this Minister were a complete reversal of the policy which the Hungarian Government had pursued for the previous twenty years, during which time it had allowed the names, so decreed to be unlawful, to be used as designations of the respective springs, and by permitting their registration under the existing Hungarian trade mark statutes, had legalized and sanctioned their use.

All these so-called decrees are therefore in the nature of ex post facto laws and are to be regarded in the light of mere edicts of a particular Minister, based upon the intricate regulations and rules of Hungarian trade mark law, which cannot be made to apply in any way to the common law of this country.

In addition to this, it is to be observed, that on petitioner's own statement, as early as 1894, the Minister of Commerce had forbidden the use by his decree, of the pictorial trade mark Hunyadi Matyas in connection with its label, whether printed in red and blue or red and white colors. The petitioner could, therefore have at once brought suit in the United States, for unfair competition, against the use of the Hunyadi Matyas label bearing the words Hunyady Matyas on its front, and brought in evidence the fact that such label and the use of the word Hunyadi Matyas in connection therewith was

forbidden in Hungary, but not only did the petitioner fail to bring suit, but also failed to act in anyway in 1894, and waited until after the new law of 1895 in relation to word trade marks had been passed, under which the entire group of Hunyadi springs was allowed registration, and further delayed any action in the United States until after the edict of the Minister had struck the word trade marks Hunyady Matyas, etc., from the registry.

The petitioner can give no valid excuse for this continued delay to take action in the United States during this period running three years, from some time in the year 1894 until the spring of 1897.

It is, however, wholly immaterial that by an *ex post facto* law, or ministerial decree, Saxlehner was allowed a trade mark in *Hungary* which had been for twenty years public property in that country.

Our courts cannot enforce the laws of a foreign country—least of all can they even recognize them where they are repugnant to the very fundamental principles of our jurisprudence. To assume for a moment, that our courts would revive an extinct trade mark in this country because such extinct trade mark had been revived in Hungary, is too manifestly unreasonable to require serious discussion.

For the above reasons, the introduction of the Hungarian decrees in evidence and testimony relating to them was duly objected to by the defendant's counsel as immaterial and irrelevant to the issues in this case, and such decrees were not considered by the Courts below as important factors in reaching their conclusions.

There are various other statements made in the petition and brief herein which we wish briefly to notice.

In the thirteenth assignment of errors set forth in the petition, it is alleged substantially that the public health is in danger by the sale of the Hungarian bitter waters under the red and blue label and using the name Hunyadi, and will be so endangered in the future.

We can best judge the future by the past, and there is not a particle of evidence in the record to show that during the years that have passed since 1888, when the free sale of Hunyadi waters began in this country, the health of any person has been in danger from their use. All the Hungarian bitter waters sold under the name Hunyadi, have as their principal constituents sulphate of magnesia and sulphate of soda. The other ingredients contained in these waters are so slight as to constitute no factors in the case.

The Hunyadi Janos water is drawn from about 112 springs, in all of which sulphate of soda and sulphate of magnesia are the main ingredients. All the Hunyadi waters are therefore alike in their effects, and these effects are due to the common cause of the presence of these substances as natural ingredients in solution. The percentages of the above substances in the various Hunyadi waters vary within limits, and according to such percentages, these waters are richer or poorer in aperient qualities, but they are all perfectly harmless in their effects, and cannot, therefore, in any way endanger the public health.

So far as regards the use of Hunyadi Matyas water in this country and its value as an aperient, it is shown by the evidence that such water obtained the highest award for excellence at the Columbian Exposition in 1893, and that up to 1896, 1,700,000 bottles of such water had been sold in the United States, and there is no evidence of any deleterious effects resulting from their use.

It is stated in the brief of petitioner that the uncontradicted testimony of fifteen physicians in the case shows that the word Hunyadi in this country still means Hunyadi Janos water, and that Judge Shipman substantially finds this fact on such testimony.

These physicians only testify substantially that they have known Hunyadi Janos water for years and prescribed it for their patients as Hunyadi

water. A careful reading of their testimony makes it clear that they have generally prescribed it in an informal way, by telling the patient to get a bottle of Hunyadi water. The fact that such physicians supposed that the patient on going to a drug store and asking for Hunyadi water, would, during the last ten years, be sure to get Hunyadi Janos water, simply shows their ignorance of what had been going on in the mineral water and drug trade, and of the true situation.

The true situation is shown by the trade evidence produced by the defendant and embodied in the record, which makes it clear that the mineral water trade of the United States had understood for eight years that no one person was entitled to the exclusive use of the word Hunyadi, and that neither buyers or sellers have known any water by the single word Hunyadi, and that by custom and usage the trade had come to know such word as a generic name for Hungarian bitter waters generally, and that in writing and speaking had distinguished such Hunyadi waters from each other by emphasizing the words "Janos," "Matyas," "Arpad," "Laszlo," "Bela," "Lajos," with which the generic word "Hunyadi" is associated.

The petitioner's counsel state in their brief substantially, that the record teems with instances of deception, and specify one particular instance as follows: "the effrontery of the principal defendant "went so far as to advertise the Hunyadi Matyas "water as the *Original* Hunyadi Water."

This refers to the fact that the complainant found one or two advertisements in trade papers speedily discontinued, in which advertisements, the Eisner & Mendelson Co. had characterized the Hunyadi Matyas water as "the original Hunyadi water of superior quality, introduced to the trade at low prices," which was a fact. The only complaint made in the Courts below by complainant was, that the words "Original Hunyadi Water" were printed in more conspicuous type than the remainder of the

sentence. The complaint now is, substantially, that the defendant printed these words without the qualifying words above quoted, which is not the fact.

All the remaining instances of alleged deception in regard to advertisements, etc., urged on the Courts below were fully explained by the defendant's evidence and shown to be unintentional, and not deceptive when explained. They nearly all relate to the early stages of the sale of Hunyadi Matyas water by the Eisner & Mendelson Co., and were discontinued within the two years running from 1890 to 1892. Although all these alleged deceptions were fully known to the Apollinaris Company, they made no protest or objection, except in one particular. In the spring of 1892, the Eisner & Mendelson Co. circulated advertisements of the Hunyadi Matyas water, showing a comparative analysis of the Hunyadi Janos, Hunyadi Arpad and Hunyady Matyas springs. This analysis was objected to by the Apollinaris Company as unfair to the Hunyadi Janos water, and after such objection, and on the request of the Apollinaris Company such advertisements were discontinued.

As found by Judge Shipman, "The Apollinaris "Company during the continuance of its Saxlehner "contract did not object to the Eisner & Mendelson "Company's operations or trade-marks, or repre-"sentations, except in one particular, which was "changed at the former's request."

The above facts show plainly the willingness on the part of Eisner & Mendelson Co. to correct anything which was regarded as unfair in its advertisements, and the circumstance that the comparative analysis was the only matter objected to by the Apollinaris Company, makes it evident that the other alleged misrepresentations, either could not be objected to, or were too trivial to warrant attention.

The attempt is made in the latter part of petitioner's brief to give the Court the impression that in England and in other countries, there has been litigation with reference to the word Hunyadi, and

that the right of the complainant to the sole and exclusive use of such word has been sustained in such litigation.

In England and other countries with the exception of Hungary and the United States, no Hunyadi waters other than the Janos water, were imported or sold during the period of the Apollinaris contract, and therefore, in these countries, there being no competition, "Hunyadi" or "Eau de Janos" have been the alternative designations for Hunyadi Janos water.

In England, after the termination of its contract, the Apollinaris Company designated a spring owned by it in Hungary as "Apenta," devised a label and made a part thereof, the "Diamond Brand," which they had used on Hunyadi Janos water during the contract. On the label also appeared the words "Uj Hunyadi," meaning new Hunyadi. Suit was thereupon brought in England by the complainant to suppress the use of these words and the Diamond Brand on the Apenta label, on the ground that by the action of the Apollinaris Company during the period of the contract in using the said Diamond mark, and the fiduciary relations created by such contract, the use of the Diamond mark and the words "Uj Hunyadi" should be suppressed. The English courts refused to grant an injunction against the use of the Diamond mark, but enjoined the Apollinaris Company from the use of the said words, on the ground of the fiduciary relations of the Apollinaris Company during the period of the contract, and because the word Hunyadi had never been lost in England, there being no substantial competition of other Hunyadi waters there, and the state of affairs being the exact opposite of the situation in the United States, where the sole and exclusive right to the word had been lost by acquiescence.

We are confident that it has been shown, that the record herein does not present such a case as is required by this Court to warrant the grant of the *writ of certiorari.*

The Court says as follows, with reference to the grant of the *writ of certiorari* in suit of *American Construction* v. *Jacksonville, T. & K. W. R. Co.*, 148 U. S. Rep., p. 383–384:

"*In the same spirit, the authority conferred on "this Court by the very provision on which the "petitioners mainly rely by which it is enacted "that 'in any such case as is hereinbefore made "final in the Circuit Court of Appeals, it shall be "competent for the Supreme Court to require, by "certiorari or otherwise, any such case to be certi-"fied to the Supreme Court for its review and deter-"mination, with the same power and authority in "the case as if it had been carried by appeal or "writ of error to the Supreme Court,' has been held "to be a branch of its jurisdiction which should "be exercised sparingly and with great caution, "and only in cases of peculiar gravity and general "importance, or in order to secure uniformity of "decision. Re Lau Ow Bew, 141 U. S., 583 and "144 U. S., 47; Re Woods, 143, U. S., 202.*"

We, therefore, submit that the application of the petitioner for the *writ of certiorari* should be refused.

Respectfully submitted,

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